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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/637,608

08/11/2003

Patrick Flynn

ENER-0001-UT1

2473

22506 7590 03/10/2008

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EXAMINER

LANGEL, WAYNE A

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

03/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/637,608
Filing Date: August 11, 2003
Appellant(s): FLYNN ET AL.

Mark J. Gutttag
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 15, 2006 appealing from the Office action mailed December 20, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

This appeal involves claims 2-4, 7-11, 45-53 and 59.

Claims 45 and 46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 15, 17, 18, 21-27, 31-34, 37-41, 54-58, 60 and 61 are withdrawn from consideration as not directed to the elected invention.

Claims 2, 5, 6, 12-14, 16, 19, 20, 28-30, 32, 35, 36 and 42-44 have been canceled.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claim 59 under the first paragraph of 35 USC 112 is withdrawn.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

US 1,643,954	PRENTICE	10-1927
US 5,221,545	BORSCHER et al	6-1993
US 4,496,639	RASMUSSEN et al	1-1985
US 2002/0197304	SCHRAUZER	12-2002
US 4,656,038	BAUGH	4-1987
French 2645622 A1	ECALLE	10-1990

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 2-4, 7-11, 47-53 and 59 stand rejected under 35 U.S.C. 103(a) as being unpatentable over FR 2645622 in view of Prentice . It would be obvious from Prentice to employ a selenium compound as the odorous compound in the composition of FR '622, since FR '622 suggests in the Abstract that any odorous gaseous product may be added, and Prentice discloses on page 2, lines 6-10 that selenides have a distinctive and repulsive odor, and establishes the equivalence between mercaptans and selenides.

Claims 2, 7-11 and 59 stand rejected under 35 U.S.C. 103(a) as being unpatentable over FR '622 in view of either Borschel et al or Rasmussen et al. It would be obvious from either Borschel et al or Rasmussen et al to employ hydrogen selenide as the odorous compound in the composition of FR '622, since FR '622 suggests in the Abstract that any odorous gaseous product may be added, and Borschel et al and Rasmussen et al both teach that hydrogen selenide has a repugnant odor. (See col. 1, lines 42-44 of Borschel et al, and col. 4, lines 21-24 of Rasmussen et al.)

Claims 2, 3, 7-11, 47-49, 52 and 59 stand rejected under 35 U.S.C. 103(a) as being unpatentable over FR '622 in view of Schrauzer. It would be obvious from Schrauzer to employ an alkyl selenol as the odorous product in the composition of FR '622, since FR '622 suggests in the Abstract that any odorous gaseous product may be employed, and Schrauzer teaches in Paragraph [0021] that selenols have an unpleasant odor.

Claims 2, 4, 7-11, 50, 51, 53 and 59 stand rejected under 35 U.S.C. 103(a) as being unpatentable over FR '622 in view of Baugh. It would be obvious from Baugh to employ dimethyl selenide or its homologs as the odorous gaseous product in the composition of FR '622, since FR '622 suggests in the Abstract that any odorous gaseous product may be employed, and Baugh teaches in col. 5, lines 40-50 that methyl selenide and dimethyl selenide produce odors that are offensive to certain types of animals.

(10) Response to Argument

Appellants' argument, that the examiner has failed to respond to appellants' request for an affidavit/declaration under 37 CFR 1.104(d)(2), is not convincing. 37 CFR 1.104(d)(2) is not applicable, since the rule is applicable when facts based on the examiner's personal knowledge are used as a basis for rejection. In this case there are no facts based on the examiner's personal knowledge which are used as a basis for rejection, since the rejections are based entirely on the prior art references which are public knowledge, and not "personal" knowledge. The prior art references speak for themselves.

Appellants' argument, that the rejection of claims 2-4, 7-11, 47-53 and 59 are based on reasoning that directly contradicts the conclusions of the restriction requirement, is not convincing. The reasoning in the rejection is not inconsistent with the reasoning for the restriction requirement, since the restriction requirement was based on the premise that the various odorous gases are separate and distinct species, whereas the rejection is based on the premise that it would be obvious to utilize any known

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odorous gaseous product in the method of FR '622, since FR '622 discloses in the English Abstract that "an odorous gaseous product" is added. In any event, the examiner is not bound by positions taken in previous actions.

Appellants' argument that the rejections of claims 2-4, 7-11, 47-53 and 59 are based on the improper grounds that the examiner believes that he can reject claims under 35 USC 103 without making a prima facie case of obviousness, is not convincing, since a prima facie case of obviousness has been made. The burden is on appellants to rebut such prima facie case.

Appellants' argument, that FR '622 does not suggest that any odorous compound may be added, is not convincing. FR '622 discloses in the Abstract that "an odorous gaseous product" is added. One of ordinary skill in the art could determine through routine experimentation which odorous gaseous products would function in the process of FR '622. The fact that certain odorous gaseous products would be impractical in the method of FR '622 does not render nugatory the fact that many would not be impractical, and it would be within the skill of one of ordinary skill in the art to determine which odorous gases would function in the process.

Appellants' argument, that the examiner has failed to identify in the Final Action where FR '622 describes the use of a single odorous product that does not contain sulfur, is not convincing. FR '622 discloses in the English Abstract that an odorous gaseous product is added, "such as" a mercaptan, a thiophane, or a product known under the name "TBM". Since the reference uses the phrase "such as" a mercaptan ...,

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it is clear that the reference contemplates other odorous gaseous products, which would include the selenium compounds recited in appellants' claims.

Appellants' other arguments are not convincing, since the secondary references are relied upon merely to show that selenium compounds are odorous. One of ordinary skill in the art would be motivated to employ such odorous selenium compounds in the process of FR '622, since it would be within the skill of one of ordinary skill in the art to determine which odorous compounds would function in the process of FR '622, and since FR '622 is not limited to the use of sulfur compounds, in view of the phrase "such as" in the English Abstract.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Wayne A. Langel

/Wayne Langel/

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